

REMARKS

In the Office Action¹ mailed June 22, 2010, the Examiner rejected claims 7-8 under 35 U.S.C. § 101 alleging that the claimed invention is directed to non-statutory subject matter; rejected claims 1 and 6-8 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,751,399 to Okabayashi et al. ("*Okabayashi*") in view of U.S. Patent No. 7,352,955 to Kotani ("*Kotani*"); and objected to claims 2-5 as being dependent upon a rejected base claim.

By this response, Applicants have amended claims 1 and 3-8 for clarity and not for reasons related to patentability. Applicants have also added new claims 9-12. No new matter has been added. Claims 1-12 remain pending and under examination.

Rejection of Claims 7-8 Under 35 U.S.C. § 101

The Examiner rejected claims 7 and 8 under 35 U.S.C. § 101, alleging that the claims "direct towards a program without specifying that the program is encoded or recorded on a non transitory computer readable medium" and "can be considered a signal per se." *Office Action*, at p. 2. Applicants respectfully disagree with the Examiner's characterization of claim 7. Claim 7 recites "a recording medium," which Applicants submit cannot be interpreted as a signal. A signal may transmit data, and may be readable by a computer, but a signal is not a recording medium, because a signal does not record anything. Applicants respectfully submit that the rejection of claim 7 under § 101 is improper and request the Examiner to withdraw it.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

While Applicants disagree with the Examiner's characterization of claim 8, to advance prosecution, Applicants have amended claim 8 to recite "[a] program, stored on a computer-readable storage device." Thus, Applicants submit that the claims cannot cover a transitory propagating signal per se. Accordingly the claims recite statutory subject matter.

While Applicants recognize that the USPTO January 26, 2010 memorandum identifies "non-transitory" as one way to overcome a § 101 rejection directed to a signal, Applicants respectfully submit that other avenues also exist. Applicants submit that a signal is not a storage device, under any interpretation of the word. Thus, a computer-readable storage device cannot be directed towards a signal per se and, for at least these reasons, Applicants respectfully request the Examiner withdraw the rejection of claim 8 under § 101.

Rejection of Claims 1 and 6-8 Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1 and 6-8 under 35 U.S.C. §103 as being obvious from *Okabayashi* in view of *Kotani*. A prima facie case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." M.P.E.P. § 2142, 8th Ed., Rev. 7 (July 2008)(internal citation and inner quotation omitted). "[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . .

[a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). In rejecting a claim, “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Claim 1 calls for a combination including, for example, “a delete control means for controlling the deletion of data from the data recording medium so as to delete the display data from the data recording medium if it is determined that the data recorded on the data recording medium is the display data.” The Office Action concedes that *Okabayashi* fails to teach or suggest this element.

The Examiner alleged that a deleting means of *Kotani* constitutes the claimed “delete control means for controlling the deletion of data from the data recording medium so as to delete the display data from the data recording medium if it is determined that the data recorded on the data recording medium is the display data.” However, this is not correct.

Kotani discloses a method of managing the reproduction duration of information data. *Kotani*, col. 1:6-10. Specifically, *Kotani* discloses a method for deleting a file using a management file directory. *Kotani*, col. 8:61-65; Fig. 10. However, *Kotani* does not disclose controlling the deletion of data if it is determined that the data recorded on the data recording medium is the display data. Indeed, *Kotani* does not disclose any type of determination made before controlling the deletion of a file. All words in a claim must be considered in judging the patentability of that claim against the prior art. M.P.E.P. § 2143.03. For at least these reasons, *Okabayashi* and *Kotani*, taken alone or in combination, fail to disclose or suggest “a delete control means for controlling the

deletion of data from the data recording medium so as to delete the display data from the data recording medium if it is determined that the data recorded on the data recording medium is the display data,” as recited by claim 1.

Applicants further submit that the Examiner improperly relies on hindsight in rejecting Applicants’ claims under § 103. The Examiner alleges that “[i]t would have been obvious to one of ordinary skill in the art to modify Okabayashi with Kotani by providing a deleting means as taught by Kotani with the apparatus of Okabayashi to enhancing [sic] the function of Okabayashi to delete non used attribute data.” *Office Action*, at p. 3. However, claim 1 does not recite deleting non-used attribute data. Rather, claim 1 recites controlling the deletion of the display data “if it is determined that the data recorded on the data recording medium is the display data.” The presence of the display data itself causes the delete control means to control deletion, not non-use of attribute data.

Moreover, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007). Applicants’ specification is the only place that teaches “a delete control means for controlling the deletion of data from the data recording medium so as to delete the display data from the data recording medium if it is determined that the data recorded on the data recording medium is the display data.” The Examiner improperly uses hindsight to allege that one of skill in the art would combine *Okabayashi* and *Kotani* in the manner claimed.

In view of the mischaracterization of the prior art set forth above, the Office Action has neither properly determined the scope and content of the prior art nor

ascertained the differences between the claimed invention and the prior art. Moreover, the Office Action has provided no motivation for one of ordinary skill in the art to modify the teachings of the prior art to achieve the claimed combinations. Accordingly, no reason has been articulated as to why one of skill in the art would find the claimed combination obvious in view of the prior art. For at least this reason, no *prima facie* case of obviousness has been established. The rejection of claim 1, and dependent claims 1 and 6-8 under 35 U.S.C. §103 as being obvious from *Okabayashi* in view of *Kotani* is thus improper and should be withdrawn.

Although of different scope, independent claims 6-8 include elements similar to those discussed above. For at least the same reasons presented above in connection with the patentability of claim 1, the Office Action does not establish a *prima facie* case of obviousness with respect to independent claims 6-8. Accordingly, these claims are patentable over the cited references and, thus, are allowable. Applicants respectfully request that the Examiner withdraw the § 103 rejection of claims 6-8.

Dependent claims 9-12 are also allowable by virtue of their dependence from allowable independent claim 6, as well as by reason of reciting additional features not taught nor suggested by the cited references.

Objection to Claims 2-5

Applicants thank the Examiner for pointing out the allowability of the subject matter of claims 2-5. However, Applicants respectfully submit that, for the reasons cited above, claim 1 is allowable over the prior art. Because claim 1 is allowable, the objection to claims 2-5 as being dependent upon a rejected base claim should be rendered moot.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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